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Gregory Maurice Plow

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PATTERSON & SHERIDAN, LLP/IBM SVL  
3040 POST OAK BLVD.  
SUITE 1500  
HOUSTON, TX 77056-6582

EXAMINER

MYHRE, JAMES W

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/922,182	<b>Applicant(s)</b> PLOW ET AL.	
	<b>Examiner</b> JAMES W. MYHRE	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is in response to the Amendment filed on February 17, 2010. The Amendment did not add nor delete any claims, but did amend Claims 1, 4, 13-19. Claims 5, 7-12, and 20-22 were previously cancelled. Thus, the currently pending claims considered below are Claims 1-4, 6, and 13-19.

### ***Claim Rejections - 35 USC § 101***

2. The Amendment filed on February 17, 2010 amended the Preambles of Claims 14-19 from "A computer program device comprising" to "A non-transitory computer readable medium containing a program, which when executed, performs an operation for storing at least one Internet advertisement, wherein the operation comprises:", thereby changing the claim from an apparatus (device) claim to a product (computer readable medium) claim. This overcomes the rejection of Claims 14-19 as being directed to non-statutory subject matter in the November 17, 2009 Office Action. Thus, **the Examiner hereby withdraws those rejections.**

***Claim Rejections - 35 USC § 112***

3. The Amendment of February 17, 2010 amended Claims 13-19 to overcome the rejection in paragraphs 3-8 of the November 17, 2009 Office Action for indefiniteness by removing the recitation of “logic means” in these claims. Thus, **the Examiner hereby withdraws those rejections.**

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 6, and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rice (6,486,891).

Claim 1: Rice discloses a method for storing Internet advertisement at a user computer, comprising:

- a. receiving Internet advertisements at the user computer automatically without the user requesting them (Figure 3, item 320; column 2, lines 41-59; and column 4, line 65 – column 5, line 5);
- b. identifying and saving the advertisements at the user computer (column 2, lines 41-59; column 5, lines 6-55; and column 6, line 11 - column 7, line 23);
- c. filtering previously displayed advertisements by one or more user attributes to determine advertisements that are eligible for display in an advertising history window (column 8, lines 1-7);
- d. recalling from the saved advertisements a user selected advertisement with a link to a website (column 2, lines 41-59 and column 8, lines 1-7); and
- e. accessing the website when the user activates the link (e.g. clicks on the link)(column 2, lines 41-59 and column 8, lines 17-20).

Rice discloses that the user accesses a requested content webpage and that advertisements are automatically displayed with the requested content. One or more of the displayed advertisements are then identified by the user selecting to “bookmark” advertisements that are of interest to the user. These advertisements (or URL links to them) are saved at the user computer so that they may be later displayed as a list to the user (e.g. in a advertising history window). The user may then select one of the advertisements by clicking on the advertisement or link within the list of stored

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(bookmarked) advertisements, which then causes the user computer to access the advertisement website.

While Rice does not explicitly disclose that all of the incoming advertisements (advertisements being displayed with the requested content) are identified and saved at the user computer (unless the user selects to bookmark all of them), it would have been a trivial matter to do so as long as the user computer had enough available memory. The Examiner also notes that all of the incoming advertisements are inherently automatically identified and saved by the user computer in order to initially display them with the content webpage (i.e. the file names and display location/formatting instructions are received, saved, and used by the user's browser to generate a combined display of the content and advertisements). These advertisements are then filtered by a selected user attribute (e.g. whether or not the user indicated to bookmark the advertisement) in order to determine which advertisements are eligible for display as part of the list in the advertising history window. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to save, not only the bookmarked advertisements, but all of the incoming advertisements, at least until the filtering is done. One would have been motivated to identify and save all of the incoming advertisements in order to allow the user to bookmark the ones of interest.

Claim 2: Rice discloses a method as in Claim 1 above, and further discloses the advertisement includes a HTML tag (column 3, lines 19-27).

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Claim 3: Rice discloses a method as in Claim 1 above, and further discloses displaying one or more buttons that, when activated, causes the display of the selected bookmarked advertisement (Figures 5 and 6; Abstract; and column 7, line 66 - column 8, line 7).

Claim 4: Rice discloses a method as in Claim 3 above, and further discloses scrolling through a list of the saved (bookmarked) advertisements based on user input (Figure 5C, item 515 and column 7, line 66 – column 8, line 7).

Claim 6: Rice discloses a method as in Claim 1 above, and further discloses displaying one or more navigational buttons as part of the graphical user interface (GUI)(Figures 5 and 6; and column 7, line 66 – column 8, line 7). The Examiner notes that “Next” and “Previous” buttons are well known navigational buttons found on most GUIs, and would have been obvious choices to display to the user in Rice. One would have been motivated to display Next and Previous buttons on the GUI in view of the familiarity of most users with the functions of these buttons.

Claim 13: Rice discloses a system for saving at least one Internet advertisement at a user computer, comprising:

- a. at least one user computer connected to a web server via the Internet (column 3, lines 29-59);

b. the user computer receiving Internet advertisements from the web server automatically without the user requesting them (Figure 3, item 320; column 2, lines 41-59; and column 4, line 65 – column 5, line 5);

c. identifying and saving the advertisements at the user computer (column 2, lines 41-59; column 5, lines 6-55; and column 6, line 11 - column 7, line 23);

d. recalling from the saved advertisements a user selected advertisement with a link to a website (column 2, lines 41-59 and column 8, lines 1-7);

e. displaying one or more navigational buttons as part of the graphical user interface (GUI)(Figures 5 and 6; and column 7, line 66 – column 8, line 7). The Examiner notes that “Next” and “Previous” buttons are well known navigational buttons found on most GUIs, and would have been obvious choices to display to the user in Rice. One would have been motivated to display Next and Previous buttons on the GUI in view of the familiarity of most users with the functions of these buttons; and

f. accessing the website when the user activates the link (e.g. clicks on the link)(column 2, lines 41-59 and column 8, lines 17-20).

Rice discloses that the user accesses a requested content webpage and that advertisements are automatically displayed with the requested content. One or more of the displayed advertisements are then identified by the user selecting to “bookmark” advertisements that are of interest to the user. These advertisements (or URL links to them) are saved at the user computer so that they may be later displayed as a list to the user (e.g. in a advertising history window). The user may then select one of the advertisements by clicking on the advertisement or link within the list of stored

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(bookmarked) advertisements, which then causes the user computer to access the advertisement website.

While Rice does not explicitly disclose that all of the incoming advertisements (advertisements being displayed with the requested content) are identified and saved at the user computer (unless the user selects to bookmark all of them), it would have been a trivial matter to do so as long as the user computer had enough available memory. The Examiner also notes that all of the incoming advertisements are inherently automatically identified and saved by the user computer in order to initially display them with the content webpage (i.e. the file names and display location/formatting instructions are received, saved, and used by the user's browser to generate a combined display of the content and advertisements). These advertisements are then filtered by a selected user attribute (e.g. whether or not the user indicated to bookmark the advertisement) in order to determine which advertisements are eligible for display as part of the list in the advertising history window. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to save, not only the bookmarked advertisements, but all of the incoming advertisements, at least until the filtering is done. One would have been motivated to identify and save all of the incoming advertisements in order to allow the user to bookmark the ones of interest.

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Claim 14: Rice discloses a computer readable medium containing instructions that when executed by a computer processor performs the steps of:

- a. receiving Internet advertisements from the web server automatically without the user requesting them (Figure 3, item 320; column 2, lines 41-59; and column 4, line 65 – column 5, line 5);
- c. identifying and saving the advertisements at the user computer (column 2, lines 41-59; column 5, lines 6-55; and column 6, line 11 - column 7, line 23);
- d. recalling from the saved advertisements a user selected advertisement with a link to a website (column 2, lines 41-59 and column 8, lines 1-7); and
- e. accessing the website when the user activates the link (e.g. clicks on the link)(column 2, lines 41-59 and column 8, lines 17-20).

Rice discloses that the user accesses a requested content webpage and that advertisements are automatically displayed with the requested content. One or more of the displayed advertisements are then identified by the user selecting to “bookmark” advertisements that are of interest to the user. These advertisements (or URL links to them) are saved at the user computer so that they may be later displayed as a list to the user (e.g. in a advertising history window). The user may then select one of the advertisements by clicking on the advertisement or link within the list of stored (bookmarked) advertisements, which then causes the user computer to access the advertisement website.

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While Rice does not explicitly disclose that all of the incoming advertisements (advertisements being displayed with the requested content) are identified and saved at the user computer (unless the user selects to bookmark all of them), it would have been a trivial matter to do so as long as the user computer had enough available memory. The Examiner also notes that all of the incoming advertisements are inherently automatically identified and saved by the user computer in order to initially display them with the content webpage (i.e. the file names and display location/formatting instructions are received, saved, and used by the user's browser to generate a combined display of the content and advertisements). These advertisements are then filtered by a selected user attribute (e.g. whether or not the user indicated to bookmark the advertisement) in order to determine which advertisements are eligible for display as part of the list in the advertising history window. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to save, not only the bookmarked advertisements, but all of the incoming advertisements, at least until the filtering is done. One would have been motivated to identify and save all of the incoming advertisements in order to allow the user to bookmark the ones of interest.

Claim 15: Rice discloses a computer readable medium as in Claim 14 above, and further discloses the advertisement includes a HTML tag (column 3, lines 19-27).

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Claim 16: Rice discloses a computer readable medium as in Claim 14 above, and further discloses displaying one or more buttons that, when activated, causes the display of the selected bookmarked advertisement (Figures 5 and 6; Abstract; and column 7, line 66 - column 8, line 7).

Claim 17: Rice discloses a computer readable medium as in Claim 16 above, and further discloses scrolling through a list of the saved (bookmarked) advertisements based on user input (Figure 5C, item 515 and column 7, line 66 – column 8, line 7).

Claim 18: Rice discloses a computer readable medium as in Claim 14 above, and further discloses the saved advertisement includes a link (URL) and a tag (applet) in which the saving is based at least in part on the tag (column 6, lines 39-60).

Claim 19: Rice discloses a computer readable medium as in Claim 14 above, and further discloses displaying one or more navigational buttons as part of the graphical user interface (GUI)(Figures 5 and 6; and column 7, line 66 – column 8, line 7). The Examiner notes that “Next” and “Previous” buttons are well known navigational buttons found on most GUIs, and would have been obvious choices to display to the user in Rice. One would have been motivated to display Next and Previous buttons on the GUI in view of the familiarity of most users with the functions of these buttons.

***Response to Arguments***

7. Applicant's arguments filed February 27, 2010 have been fully considered but they are not persuasive.

a. The Applicant argues that Rice "cannot teach receiving Internet advertisement at the user computer automatically without the user requesting them." (page 8). However, the Examiner notes that Rice explicitly discloses "a page request is received from the client. The server responds to the page request by transmitting the requested page at step 320. One or more advertisement may be embedded within the requested page." (column 4, line 65 - column 5, line 2). Thus, the user requests a content webpage and one or more Internet advertisements are automatically received and displayed along with the requested content (see also column 3, lines 51-59).

b. The Applicant also argues that Rice does not disclose automatically identifying and saving the advertisements at the user computer (pages 8-9). However, as noted in the rejection above, all of the incoming advertisements are inherently automatically identified and saved by the user computer in order to initially display them with the content webpage (i.e. the file names and display location/formatting instructions are received, saved, and used by the user's browser to generate a combined display of the content and advertisements). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Rice to save, not only the bookmarked advertisements, but all of the incoming advertisements, at least until the filtering is done.

c. The Applicant further argues that Rice does not disclose “recalling at least one user-selected advertisement from the saved advertisements, for display in an advertisement history window”. The Examiner notes that Rice discloses displaying a window that only displays the saved bookmarked advertisements that the user may click on to access a webpage associated with the advertisement.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571) 272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM  
May 4, 2010

/James W Myhre/  
Primary Examiner, Art Unit 3688